

REMARKS/ARGUMENTS

Status

No claim has been cancelled by the present amendment. Claims 1-57, including independent claims 1, 29 and 45, will remain for further consideration.

More Clearly Defined

The claims in this application have been revised to voluntarily further clarify Applicant's unique invention. Applicant maintains that the claims as filed were patentable over the art of record. However, to expedite issuance of this application, reconsideration of the claims in light of the amendments and for the following reasons is respectfully requested.

Claim History

The Examiner rejected claims 1-44 under 35 U.S.C. § 112, first paragraph, as being indefinite. The Examiner rejected claims 29-44 under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner rejected claims 1-4, 6-16, 21-36, and 40-44 under 35 U.S.C. § 103 over Everingham in view of Walker. The Examiner rejected claim 5 under 35 U.S.C. § 103 over Everingham in view of Walker and in further view of Bouchard. The Examiner rejected claims 17-20, 36-39 and 52 under 35 U.S.C. § 103 over Everingham in view of Walker and in further view of Geiger et al.

Claims Allowed

The indication by the Examiner in the recent Office Action that claims 45-57 were allowable over the prior art of record is noted with appreciation.

35 U.S.C. § 112

The Examiner rejected claims 1-44 under 35 U.S.C. § 112, first paragraph, as being indefinite. The Examiner rejected claims 29-44 under 35 U.S.C. § 112, second paragraph, as being indefinite. The amendment of claim 29 should obviate the rejection of claims 29-44.

As to claims 1-44, the Examiner objected as “unsupported” the recitation in claim 1 that “wherein an escrow unencryption key for unlocking said escrow encryption key is not made available to said recipient.” The Examiner pointed to the phrase in paragraph [0096] that the “escrow manager *could* transmit the escrow decryption key as part of the receiving system 300” (Emphasis Added) as allegedly meaning that it *must* transmit the key or that there is allegedly no other alternative explicitly provided and therefore the embodiment must prevail in interpreting the claims.

However, the Applicant respectfully submits that is not limited to claiming a particular preferred embodiment of the invention, and the fact that the invention “can be” operated in an alternate method, such as the escrow manager “can” transmit the escrow key, does not limit the claims to such an embodiment. One skilled in the art would recognize that encryption has very little value if the unlocking keys are provided to the general public and are therefore the keys are not normally disclosed to others. In fact the name of the key generally tells one of ordinary skill in the art who is in possession of the public or private key, for example, a recipient’s private key would be assessable

only by the recipient and an escrow private key would be assessable only by the escrow agent. One skilled would also recognize that if a particular unlocking key “could” be provided to someone, then it would in general situations “not” be provided to that person. Additionally, the next sentence in the quoted paragraph [0096] states that “alternatively, the OC 200 or escrow manager 211 could decrypt the document 3 and re-encrypt it with the recipient 300’s public key prior to transmitting 555 it to the recipient 300.” It is clear to one of ordinary skill in the art that the escrow key in this embodiment would not be transmitted to the recipient since escrow keys are by their very nature and definition confidential.

However, by the very fact that the disclosure was listed as an alternative (i.e., by the introductory word “could”), the element can by rule be excluded in the claims: “If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) (“[the] specification, having described the whole, necessarily described the part remaining.”). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff ’d mem.*, 738 F.2d 453 (Fed. Cir. 1984)” MPEP 2173.05(i) Additionally, even if the element was not listed in alternative, the general character of an encryption key would support its non-disclosure to the recipient as discussed above. See also MPEP 2173.05(i) (“A lack of literal basis in the specification for a negative limitation *may not* be sufficient to establish a *prima facie* case for lack of descriptive support.” *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993).” Emphasis Added)) “The purpose of the written description requirement is to prevent an applicant from later asserting that he invented that which he did not; the applicant for a patent is therefore required ‘to recount his invention in such detail that his future claims can be determined

to be encompassed within his original creation.” *Amgen Inc. v. Hoechst Marion Roussel Inc.*, 314 F.3d 1313, 1330 (Fed. Cir. 2003). “Compliance with § 112 requires sufficient information in the specification to show that the inventor possessed the invention at the time of that original disclosure.” *Pandrol*, 424 F.3d at 1165. In evaluating whether this requirement has been fulfilled, the application’s “disclosure must allow one skilled in the art ‘to visualize or recognize the identity’ of the subject matter purportedly described.” *Regents of Univ. of Cal. V. Eli Lilly & Co.*, 119 F.3d 1559, 1573 (Fed. Cir. 1997) “*Terms need not be used in haec verba, however...Instead, we have explained that the written description requirement can be satisfied by ‘words, structures, figures, diagrams, formulas, etc.’*” *Kotto Manufacturing Co., Ltd. v. Turn-Key-Tech, LLC*, 381 F.3d 1142, 1154 (Fed. Cir. 2005)(emphasis added) Therefore, there is ample evidence that the claims in supported by its present language in the specification as filed. For at least these reasons, the §112 rejection of claims 1-44 should be withdrawn.

35 U.S.C. § 103

The Examiner rejected claims 1-4, 6-16, 21-36, and 40-44 under 35 U.S.C. § 103 over Everingham in view of Walker. The Examiner rejected claim 5 under 35 U.S.C. § 103 over Everingham in view of Walker and in further view of Bouchard. The Examiner rejected claims 17-20, 36-39 and 52 under 35 U.S.C. § 103 over Everingham in view of Walker and in further view of Geiger et al. These rejections are respectfully traversed.

Obviousness, ultimately, is a determination of law based on underlying determinations of fact. Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH, 139 F. 3d 877, 881 (Fed. Cir. 1998) "These underlying factual determinations include (1) the scope and

content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and, (4) the extent of any proffered objective indicia of non-obviousness." Id.

"During examination, *the examiner bears the initial burden of establishing a prima facie case of obviousness...*The prima facie case is a procedural tool, and requires the examiner to initially produce evidence to support a ruling of obviousness. In re Kumar, 418 F.3d 1361, 1366, 76 USPQ 1048 (Fed. Cir. 2005)(emphasis added).

The invention must be considered as a whole without the benefit of hindsight, and the claims must be considered in their entirety. Rockwell International Corp. v. United States, 147 3 F.3d 1358, 1364 (Fed. Cir. 1998)

"One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fine, 837 F.2d 1071, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988). It is impermissible to use the claimed invention as a blueprint from which to reconstruct the prior art to satisfy the claimed invention. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 227 USPQ 543, 548 (Fed. Cir. 1985) ("From its discussion of the prior art it appears to us that the court, guided by the defendants, treated each reference as teaching one or more of the specific components for use in the Feil system, although the Feil system did not then exist. Thus the court reconstructed the Feil system, using the blueprint of the Feil claims. As is well established, this is legal error.")

The prior art must be considered as a whole and suggest the desirability and thus the obviousness of making the combination. Lindermann Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984)

There must be a suggestion or motivation in the prior art to modify a reference to satisfy the claimed invention. In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification."

Id. (emphasis added)

"When an obviousness determination is based on multiple references, there must be a showing of some 'teaching, suggestion, or reason' to combine the references...Although a reference need not expressly teach that the disclosure contained therein should be combined with another the showing of combinability, in whatever form, must be '*clear and particular*.'" Winner International Royalty Corp. v. Wang, 202 F.3d 1340, 1348-1349 (Fed. Cir.), cert. denied, 530 U.S. 1238 (2000)(emphasis added)

"The factual inquiry whether to combine references must be thorough and searching'...*It must be based on objective evidence of record*. This precedent has been reinforced in myriad decisions and cannot be dispensed with...The need for specificity pervades this authority...This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority...'Common knowledge and common sense,' even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority." In re Lee, 277 F.3d 1338, 1343-1345 (Fed. Cir. 2002)

"There is no suggestion to combine, however, if a reference teaches away from its combination with another source." Tech Air, Inc., 192 F.3d at 1360 (emphasis added). See also Winner International Royalty Corp., 202 F.3d at 1349-1350 ("Second, if Johnson did in fact teach away from Moore, then that finding alone can defeat Wang's obviousness claim.")

"A reference may be said to teach away when a person of ordinary skill, upon reading the reference would be discouraged from following the path set *out* in the reference, or would be led in a direction divergent from the path taken by the applicant... [or] if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by applicant." In re Gurley, 27 F. 3d 551, 553, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994) and Tech Air, Inc. v. Denso Mfg. Michigan Inc., 192 F.3d 1353, 1360 (Fed. Cir. 1999).

The Applicant objects to the Examiner's characterization of Walker's disclosure as showing the generation of an "escrow key pair." Walker specifically states "If the recipient has no published locking key, then the key server may assign a new locking and unlocking key pair to the recipient. The key server then provides the new locking key to the sender and the new unlocking key to the recipient." Although the Examiner may take a broad reading of claim language, the Examiner cannot read a reference to go against the teaching of the reference. Clearly, a key which is sent to a recipient is a "recipient's key" and one of ordinary skill in the art would not consider this to be an "escrow key not equal to a recipient's public key," especially since Walker clearly defines the element as the recipient's public key. In any case, the claim clearly recites that the "escrow encryption key" is "not equal to the recipient's public key." Walker clearly states the key is assigned to the recipient, becomes his public key, and is entered into the database to be stored as the

recipient's public key, "the key server may assign a new locking and unlocking key pair to the recipient." ¶ 0041. "If no such public key is found in the local key store, the client component then sends to the key server a request for the public key associated with the recipient's electronic mail address." ¶0041. The system "sends a notification to the recipient's electronic mail address notifying the recipient that a public and private key pair has been assigned to the recipient and that the recipient will receive an electronic mail message encrypted using the new public key." ¶0041 This by definition makes the key the recipient's public key. In any event, there is no disclosure of a key being provided to the recipient that is different from the key used to encrypt the document, after the system fails to find a listed public key."

The claim further recites the limitation that the encryption key is not made available to the recipient. As discussed above in relation to the § 112 rejection, a decryption key is only valuable if it is kept in confidence. As one skilled in the art would readily recognize, a posted decryption key that anyone can utilize has no value in keeping a document in confidence. And a secure system is not likely to send off an internal escrow decryption key to a member of the public ("recipient") so that the recipient can decrypt any messages held on the escrow system. The claim clearly differentiates between the confidential escrow encryption key that is kept in confidence and the public key of the recipient's key which is provided to the recipient. Once the key of Walker is provided to the recipient and stored in the database as associated with the recipient, that key is by definition the recipient's key. The claims clearly provide that the escrow key is *not* equal to the recipient's key and is not provided to the recipient. Nowhere is this shown in Walker.

Nowhere does Walker show the different types of keys, and the Examiner's impermissible renaming of the clearly labeled recipient's key still does not provide for both the recipient's key and the escrow key. The terminology used in the specification must be given its ordinary meaning unless the Applicant has explicitly given the terminology different meaning. Here, the terminology "recipients key" (both public and private) are those keys that are associated with the recipient, and those which the recipient uses in the normal course to send and receive encrypted messages.

The Applicant has clearly distinguished between the escrow key and the recipient's key, and the Examiner may not ignore the plain meaning of the terms, the recitations of the claims, and the clear terminology of the prior art references to reject the claims. If the claim were fairly susceptible to two constructions, that should be adopted which will secure to the patentee his actual invention . Smith v. Snow, 294 U.S. 1, 14, 79 L. Ed. 721, 55 S. Ct. 279 (1935). The terms of the claims are to be interpreted in light of the specification and drawings. See Toro Co. v. White Consolidated Industries Inc., 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a "lexicographic vacuum, but in the context of the specification and drawings."). "The claim word 'including' is not construed in a lexicographic vacuum, but in the context of the specification and drawings." E.g., Adams v. United States, 383 U.S. 39, 49, 15 L. Ed. 2d 572, 86 S. Ct. 708 (1966) ("it is fundamental that claims are to be construed in light of the specifications and both are to be read with a view to ascertaining the invention"). Clearly, the term "recipient public key" is distinct from "escrow encryption key" and Walker's recipient'.

For at least these reasons, claims 1-44 should be allowed over the art of record.

As to Bouchard and Geiger, neither of these references is relied upon, nor do they teach the elements lacking in the unobvious combination of Everingham and Walker. Therefore, the rejected claims should be allowable for at least the reasons that the independent claim is allowable.

Summary

Applicants have made a diligent and bona fide effort to answer each and every ground for rejection or objection to the specification including the claims and to place the application in condition for final disposition. Reconsideration and further examination is respectfully requested, and for the foregoing reasons, Applicant respectfully submits that this application is in condition to be passed to issue and such action is earnestly solicited. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Robert N. Blackmon, Applicants' Attorney at 703-684-5633 to satisfactorily conclude the prosecution of this application.

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Respectfully submitted,



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